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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/647,660 | 08/25/2003 | Simon Handelsman | 4316/037 | 2140 |
| 22440 | 7590 | 09/10/2004 | EXAMINER | |
| GOTTLIEB RACKMAN & REISMAN PC 270 MADISON AVENUE 8TH FLOOR NEW YORK, NY 100160601 | | | NGUYEN, SON T | |
| | | ART UNIT | PAPER NUMBER | |
| | | 3643 | | |

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|---------------------------|----------------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/647,660 | HANDELSMAN, SIMON |
| | Examiner Son T. Nguyen | Art Unit 3643 <i>MW</i> |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 21 June 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-16 and 18-35 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-16 and 18-35 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1-6,8,11-13,32,34** are rejected under 35 U.S.C. 102(b) as being anticipated by US 4825812 on form PTO-1449 (herein 812).

For claim 1, 812 discloses a pet chew, comprising: a first member 2; a second member 2; means 3 for mounting the first member and the second member in a rotatable orientation, wherein the first member and the second member are rotatable relative to one another around an axis of rotation; a plurality of scrubbing elements 7 (also, col. 3, lines 67-68 and col. 4, lines 1-4) mounted on a first surface of the first member; and a plurality of scrubbing elements 7 (also, col. 3, lines 67-68 and col. 4, lines 1-4) mounted on a first surface of the second member; wherein the first surface of the first member and the first surface of the second member are generally perpendicular to the axis of rotation.

For claim 2, 812 discloses wherein the first surface of the first member and the first surface of the second member are generally parallel to one another.

For claim 3, 812 discloses wherein the means for mounting includes a shaft 3.

For claim 4, 812 discloses wherein the first member and the second member are mounted on the shaft.

For claim 5, 812 discloses spacing means 1 for spacing the first member relative to the second member.

For claim 6, 812 discloses wherein the spacing means comprises a hub 1 disposed between the first surface of the first member and the first surface of the second member.

For claim 8, 812 discloses retaining means 5 for retaining the first member and the second member on the shaft.

For claim 11, 812 discloses wherein each of the scrubbing elements is adapted to scrub at least one of: (a) a tooth; and (b) a gum.

For claim 12, 812 discloses wherein said first surface of said first member and said first surface of said second member face each other (at their edges).

For claim 13, 812 discloses wherein the scrubbing elements are mounted on said surfaces of said members in rows.

For claim 32, 812 discloses a method of providing dental care to a pet having teeth, comprising: mounting a first member 2 of a pet chew and a second member 2 of the pet chew in a rotatable orientations wherein the first member and the second member are rotatable relative to one another around an axis of rotation; mounting a plurality of scrubbing elements 7 (also, col. 3, lines 67-68 and col. 4, lines 1-4) on a first surface of the first member; and mounting a plurality of scrubbing elements 7 (also, col. 3, lines 67-68 and col. 4, lines 1-4) on a first surface of the second member; wherein the first surface of the first member and the first surface of the second member are generally perpendicular to the axis of rotation; and wherein movement during chewing

of the pet chew by the pet, by at least one tooth of the pet against at least one of: (a) at least one of the scrubbing elements; (b) the first member; and (c) the second member causes the first member and the second member to rotate relative to one another.

For claim 34, 812 discloses wherein the scrubbing elements mounted on said first surface of the first member are in facing relationship to the scrubbing elements mounted on the first surface of the second member. Note, although the ends of the wheels 2, which includes the ends of the scrubbing elements 7, are separated by ref. 1, they are nevertheless facing each other.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 7,9,10,15** are rejected under 35 U.S.C. 103(a) as being unpatentable over 812 (as above) in view of D307339 (herein 339).

For claim 7, 812 lacks a hub formed of a raised portion of at least one of the first surface of the first member and the first surface of the second member. 339 teaches a pet chew in which a hub is formed as part of a raised portion of a surface of disc member (fig. 2 shows hubs in between discs). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ raised portion as taught by 339 in between members 2 of 812 in order to separate the members from one another.

For claim 9, 812 discloses the members 2 can be in any shape (col. 3, lines 60-68) but not specifically circular disc. In addition to the above, 339 teaches disc shaped members. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ disc shaped members as taught by 339 in the pet chew of 812, depending on the user's preference to have such shape for appealing appearance.

For claim 10, 812 as modified by 339 (for the disc feature) discloses at least one additional scrubbing element 7 mounted on at least one of: (a) an outer circumferential surface of the first disk; and (b) an outer circumferential surface of the second disk.

For claim 15, it would have been obvious to one having ordinary skill in the art at the time the invention was made to mount the scrubbing elements of 812 as modified by 339 in circular rows along said surfaces, depending on the user's preference for the desired pattern of scrubbing elements for appealing appearance.

5. **Claim 14** is rejected under 35 U.S.C. 103(a) as being unpatentable over 812 (as above). It would have been obvious to one having ordinary skill in the art at the time the invention was made to mount the scrubbing elements of 812 in offset rows, depending on the user's preference for the desired pattern of scrubbing elements for appealing appearance.

6. **Claims 16,18-22,24-30,33,35** are rejected under 35 U.S.C. 103(a) as being unpatentable over 812 (as above) in view of US 6688258 (herein 258).

For claims 16 & 35, 812 discloses a pet chew, comprising: a plurality of cylindrical member 2, wherein each of the member includes an obverse surface (any

surface that is opposite the reverse surface such as where ref. 8 is pointing at in fig. 4), a reverse surface (any surface that is opposite the obverse surface such as the left side horizontal to where ref. 8 is pointing at in fig. 4), and an outer circumferential surface (any surface such as where ref. 7 is pointing at in fig. 4); means 3 for mounting the members in a rotatable orientation, wherein the members are rotatable relative to one another around an axis of rotation; and a plurality of scrubbing elements 7 mounted on at least one of the obverse surface and the reverse surface of each member. 812 further state that the members 2 can be other shapes (col. 4, lines 1-5) but does not specified disc shape.

258 teaches a pet chew (fig. 5) comprising circular discs 80 having obverse, reverse and outer circumferential surfaces mounted on rope shaft 44, wherein the obverse surface and the reverse surface of each disk are generally perpendicular to the axis of rotation, wherein the obverse surface of one of said disks has said plurality of scrubbing elements mounted in a substantially facing relationship to said plurality of scrubbing elements mounted on the reverse surface of another of said disks. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ disc shape as taught by 258 as the preferred shape for the members 2 of 812, depending on the user's preference to make the chew more appealing in appearance.

For claim 18, 812 as modified by 258 discloses wherein the obverse surface and the reverse surface of each disk are generally parallel to one another (if one draws

vertical tangent lines on the left and right side of member 2, the surfaces would be parallel, fig. 4 of 812).

For claim 19, 812 as modified by 258 (emphasis on 812) wherein the means for mounting includes a shaft 3.

For claim 20, 812 as modified by 258 discloses wherein each disk (as modified with 258) is mounted on the shaft.

For claim 21, 812 as modified by 258 (emphasis on 812) discloses spacing means 1 for spacing the disks relative to one another.

For claim 22, 812 as modified by 258 (emphasis on 812) wherein the spacing means comprises a hub 1 disposed between one of the obverse surface and the reverse surface of one disk and one of the obverse surface and the reverse surface of another disk.

For claim 24, 812 as modified by 258 (emphasis on 812) discloses retaining means 5 for retaining the disks on the shaft.

For claim 25, 812 as modified by 258 (emphasis on 812) discloses at least one additional scrubbing element 7 mounted on the outer circumferential surface of at least one of the disks.

For claim 26, 812 as modified by 258 (emphasis on 812) discloses wherein each of the scrubbing elements is adapted to scrub at least one of: (a) a tooth; and (b) a gum.

For claim 27, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the number of discs of 812 as modified by 258 being in the range of 1 to 16, since it has been held that where routine testing and

general experimental conditions are present, discovering the optimum or workable ranges until the desired effect is achieved involves only routine skill in the art.

For claim 28, 812 as modified by 258 (emphasis on 258) discloses wherein the scrubbing elements mounted on at least one of the obverse surface and the reverse surface of at least one disk are mounted in circular rows (see fig. 4).

For claim 29, it would have been obvious to one having ordinary skill in the art at the time the invention was made to offset at least one row of scrubbing elements of 812 as modified by 258, depending on the user's preference for a more appealing in appearance chew.

For claim 30, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the number of discs of 812 as modified by 258 being in the range of 1 to 16, since it has been held that where routine testing and general experimental conditions are present, discovering the optimum or workable ranges until the desired effect is achieved involves only routine skill in the art.

For claim 33, 812 discloses a method of providing dental care to a pet having teeth, comprising: mounting a plurality of members 2 in a rotatable orientation, wherein the members are rotatable relative to one another around an axis of rotation; and mounting a plurality of scrubbing elements 7 on at least one of an obverse surface (any surface that is opposite the reverse surface such as where ref. 8 is pointing at in fig. 4), and a reverse surface (any surface that is opposite the obverse surface such as the left side horizontal to where ref. 8 is pointing at in fig. 4) of each member; wherein movement, during chewing of the pet chew by the pet, by at least one tooth of the pet

against at least one of; (a) at least one of the scrubbing elements; and (b) at least one of the disks causes the disks to rotate relative to one another. 812 further state that the members 2 can be other shapes (col. 4, lines 1-5) but does not specified disc shape.

258 teaches a pet chew (fig. 5) comprising circular discs 80 having obverse, reverse and outer circumferential surfaces mounted on rope shaft 44, wherein the obverse surface and the reverse surface of each disk are generally perpendicular to the axis of rotation. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ disc shape as taught by 258 as the preferred shape for the members 2 in the method of 812, depending on the user's preference to make the chew more appealing in appearance.

7. **Claim 23** is rejected under 35 U.S.C. 103(a) as being unpatentable over 812 as modified by 258 as applied to claims 16,21 above, and further in view of 339 (as above). 812 as modified by 258 lacks a hub formed of a raised portion of at least one of the first surface of the first member and the first surface of the second member.

339 teaches a pet chew in which a hub is formed as part of a raised portion of a surface of disc member (fig. 2 shows hubs in between discs). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ raised portion as taught by 339 in between members 2 of 812 in order to separate the members from one another.

8. **Claim 31** is rejected under 35 U.S.C. 103(a) as being unpatentable over 812 as modified by 258 as applied to claim 16 above, and further in view of US D473683 (herein 683). 683 teaches a pet chew having circular discs defining a ball shaped

configuration. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the circular discs of 812 as modified by 258 defining a ball shaped configuration as taught by 683, depending on the user's preference to make the chew more appealing in appearance.

Response to Arguments

9. Applicant's arguments filed 6/21/04 have been fully considered but they are not persuasive.

Applicant argued that "What the Examiner fails to appreciate is that the Visalli device, while arguably including two members (the rubber wheels) independently rotatable about an axis of rotation (shaft 3) with surfaces formed with a plurality of scrubbing elements (ribs 7), nonetheless fails to teach having these surfaces perpendicular to the axis of rotation. Rather, as shown in Figs. 1 and 2 of the Visalli patent, surfaces 8 of rubber wheels 1 and 2 are instead coaxial with and/or circumferential with respect to the axis of rotation (of the wheels) as defined by shaft 3. This is precisely not what is described and claimed in the subject application, in which the first surface of the first rotating member and the first surface of the second rotating member are, in general, perpendicular to the axis of rotation. This, in turn, provides for the scrubbing elements mounted along the surfaces of each member to be disposed in a far more advantageous position/orientation than what is found in the Visalli teaching."

Visalli does teach the members being rotatable relative to one another around the shaft (col. 2, lines 60-68). The only member that is rotatably independent from the

other members 2 is that of ref. 1, which wasn't even considered as a member in the above rejection. Clearly from col. 2, lines 60-68, the wheels or members 2 are rotatable relative to each other, "When a horse bites or chews a wheel 2; both the wheel 2 and the shaft 3 will rotate..."

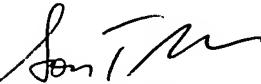
Unfortunately, the claim language does not clearly described in detailed the claimed or argued invention, therefore, it is being interpret as broadly as it is being claimed. For example, claiming a first surface of a first member and a first surface of a second member being generally perpendicular to the axis of rotation can mean any surfaces on the member, depending on the line of reference where one defines perpendicular. Take a look at fig. 4 of Visalli, and let say that the axis of rotation is clockwise, well, any surface (say where refs. 7 or 8 is pointing at) can or is perpendicular to axis of rotation if one defines an imaginary line drawn from the center of the wheel to, say ref. 8. Doesn't that makes that surface that the imaginary line crosses generally perpendicular to the axis of rotation? One can pick any surface on the wheel because the claim language merely states "a surface". Furthermore, the Examiner reviewed the specification but did not find where it teaches this perpendicular to the axis of rotation and the importance of this perpendicular to the axis of rotation as argued.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son T. Nguyen whose telephone number is (703) 305-0765. The examiner can normally be reached on Monday - Friday from 9:00 a.m. to 5:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon, can be reached at (703) 308-2574. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Customer Service at (703) 872-9325. The official fax number is 703-872-9306.



Son T. Nguyen
Primary Examiner, GAU 3643
September 8, 2004